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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,154	01/16/2002	Mark E. Yacovone	59994-023 (BSKK-001)	1058
7590 Toby H. Kusmer McDermott, Will & Emery 28 State Street Boston, MA 02109			EXAMINER BECKER, SHAWN M	
			ART UNIT 2173	PAPER NUMBER

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/052,154

Applicant(s)

YACOVONE ET AL.

Examiner

Shawn M. Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 1-27 and 40-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Claim 1 recites the limitation "said computer processor" in line 8 of the claim. There is insufficient antecedent basis for this limitation in the claim. Since, both the composer system and host computer include a computer processor, it is unclear as to which computer processor is being referred.
3. Claims 12 and 40 are indefinite because they states that the merge page enables copying of either visual slides or audio narration clips, then state that the contents windows display the titles of visual slides, but if the merge page only enables copying of audio narration clips then there are no visual slides for which to display a title.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-11, 15-16, 18-23, 25, 27-39, 43-44, 46-51, 53, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,784,899 to Barrus et al. (hereinafter Barrus).

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Referring to claims 1, 28, and 55, Barrus teaches a system and method for composing audio-visual presentations (multimedia messages) over a communications network (i.e. col. 1, lines 25-36) comprising; a composer system (multimedia message system) including a computer processor (i.e. within a personal computer; col. 2, line 6) and associated memory and a telephone device (i.e. col. 2, lines 50-54), the composer system having a presentation containing at least one visual portion of a message stored in said memory (visual message portions; i.e. col. 2, lines 38-41 and col. 8, lines 11-31); and

a host system including a computer processor and associated memory;

wherein said composer system:

A. establishes a connection between the computer processor and said host system over a communications network (i.e. col. 12, lines 38-43) and uploads the presentation to said host system over said communications network (see Fig. 4E, col. 5, line 23 – col. 6, line 24, and col. 10, lines 55-67, which describes how multimedia messages may be accessed remotely); and

B. establishes a connection between the telephone device and the host system (Fig. 4E, 124) and records an audio narration clip for each of said at least one visual portion of the message (see col. 22, lines 24-38); and

wherein the host system synchronizes each audio narration clip with its associated visual portion and stores the resulting audio-visual presentation in said memory of said host system. See col. 8, lines 11-52, col. 10, lines 19-54, and col. 14, lines 50-62, which describe associating the audio portions with the visual portions of the multimedia message (audio-visual presentation).

Barrus does not explicitly state that the visual portion of the message is a visual slide, but Barrus does teach that the visual portion may be any type of image, graphic, or document (i.e. col. 23, lines 32-37), and since a visual slide is a type of image, Barrus implicitly implies that the visual portion of the message may be a visual slide. It would have been obvious to one of ordinary skill in the art to use a visual slide as the image (visual portion) of the message of Barrus in order to easily create/store an image that conveys the desired expression as supported in Barrus (col. 1, lines 25-58).

Referring to claims 2 and 29, Barrus teaches that the host system includes an interactive voice response system which is connectable to the telephone device of said composer system and which processes said audio narration clips. See col. 4, lines 10-33.

Referring to claims 3 and 30, Barrus teaches that the interactive voice response system is responsive to inputs provided by the composer system through a keypad of the telephone device. See col. 4, lines 15-16 and col. 22, lines 31-33.

Referring to claims 4 and 32, Barrus does not explicitly teach that the at least one visual slide/message is in the form of a Powerpoint® slide, a Visio® graphic, a Word® document, an Excel® document, or an Adobe® PDF file, but Barrus does teach that the at least one visual slide/message may be any type of image, graphic, or document (i.e. col. 23, lines 32-37), since a Powerpoint® slide, a Visio® graphic, a Word® document, an Excel® document, and an Adobe® PDF file are types of images, graphics, and documents, Barrus implies that the visual slide/message is in the form of one of a Powerpoint® slide, a Visio® graphic, a Word® document, an Excel® document, and an Adobe® PDF file. It would have been obvious to one of ordinary skill in the art to use a Powerpoint® slide, a Visio® graphic, a Word® document, an

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Excel® document, or an Adobe® PDF file as the visual slide (portion of the multimedia message) of Barrus in order to utilize efficient preexisting software for the image creation within the method of Barrus.

Referring to claims 5 and 33, the communications network of Barrus is the Internet. See col. 12, line 42.

Referring to claims 6 and 34, communications network of Barrus is an intranet. See col. 12, lines 38-43.

Referring to claims 7 and 35, Barrus teaches that the host system includes at least one graphical user interface that is transmitted to the composer system for enabling said composer system to compose said audio-visual presentation. See Figs. 7 and 15 and col. 23, lines 9-31.

Referring to claims 8 and 36, that one of said at least one graphical user interfaces includes a slide upload page including a text box for enabling the composer system to enter the name of the presentation containing at least one visual slide which is to be uploaded to said host system. See col. 23, lines 16-31 and col. 26, lines 40-42.

Referring to claims 9 and 37, Barrus discloses that one of the at least one graphical user interfaces includes an audio recording page for enabling the composer system to record said audio narration clips (i.e. col. 22, lines 11-38), including a current slide window for displaying the slide (message) for which an audio narration clip is being recorded and a recording navigation window (i.e. col. 24, lines 4-34), including a list of functions associated with the keys on a keypad of said telephone device (i.e. Fig. 7, 716).

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Referring to claims 10 and 38, the audio recording page of Barrus further includes a contents window for displaying a title (subject) of each visual slide (multimedia message) of a selected presentation. See Fig. 7, 702.

Referring to claims 11 and 39, Barrus discloses that one of the at least one graphical user interfaces includes an edit page for enabling the composer system to perform edit functions (i.e. add or append objects) within a presentation, said edit page including a contents window for displaying a title of each visual slide of a selected presentation and a slide preview window (thumbnail) for displaying a slide which has been selected in said contents window for editing. See col. 22, lines 16-22 and col. 23, lines 9-31.

Referring to claims 15 and 43, the system of Barrus further comprises at least one viewer system (i.e. personal computer), each including a computer processor and associated memory, wherein said viewer system is connectable to said host system over said communications network for receiving a presentation stored on said host system for viewing. See Fig. 4E and col. 10, lines 55-67.

Referring to claims 16 and 44, Barrus teaches that upon connecting to the host system over the communications network, the viewer system is able to view a presentation (multimedia message) stored on said host system as the presentation is received by the viewer system. See col. 24, lines 35-46, which describes receiving a message nearly at the same time as it is added to the system. Also, see col. 15, line 55 – col. 17, line 33.

Referring to claims 18 and 46, the host system of Barrus includes a tracking component that records information about said presentations (messages), including the identity of the

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composer system that composed a particular presentation (who the presentation/message is from; Fig. 7, 702).

Referring to claims 19 and 47, Barrus teaches that the audio narration clips are played through the computer processor of said viewer system (i.e. through the processor in the phone with LCD display acting as viewer system as in col. 6, lines 3-23).

Referring to claims 20 and 48, Barrus teaches that the viewer system further comprises a telephone device that is connectable to said host system and said audio narration clips are played through said telephone synchronous with its associated visual slide. See col. 10, lines 55-67.

Referring to claims 21 and 49, Barrus discloses that the host system includes a security component for controlling access to the presentations by the at least one viewer system. See col. 14, lines 4-22.

Referring to claims 22 and 50, Barrus teaches that the security component requires that the viewer system provide an assigned identification index (ID number) before accessing said presentations. See col. 15, line 55 – col. 16, lines 21.

Referring to claims 23 and 51, Barrus teaches that the identification index provides the viewer system with access to less than all of the presentations stored on said host system (i.e. only those for the specified user profile; col. 6, line 50 and col. 15, line 55 – col. 16, line 21).

Referring to claims 25 and 53, Barrus teaches uploading new slides. See col. 23, lines 16-31.

Referring to claims 27 and 31, the interactive voice response system of Barrus includes a speech recognition component that is responsive to verbal inputs provided by the composer system through a transmitter of the telephone device. For example, see col. 26, lines 40-44.



6. Claims 12-14, 17, 40-42, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrus and "To Upload or Change your Home Page" from bright.net (hereinafter bright.net).

Referring to claims 12 and 40, Barrus teaches merging visual images from a source to a destination (col. 23, lines 9-31), but does not explicitly show a merge page for enabling the composer system to edit a presentation by copying at least one of visual slides and audio narration clips from a source presentation to a destination presentation that includes a source presentation contents window for displaying the title of each visual slide of a source presentation and a destination presentation contents window for displaying the contents of a destination presentation. However, bright.net shows a screenshot of an FTP interface, used for copying files from one system to another, which shows a source content window with the titles of source files and a destination content window with the titles of destination files. It would have been obvious to one of ordinary skill in the art to utilize an interface such as shown in bright.net for the selection of files (visual slides) within the multimedia composition method of Barrus in order to efficiently retrieve the desired files as shown in bright.net.

Referring to claims 13-14 and 41-42, Barrus teaches a preview window (thumbnail image) for displaying a selected slide (col. 23, lines 18-31). Bright.net teaches a source window and destination window. Therefore, it would have been obvious to one of ordinary skill in the art to include the preview window (thumbnail image) of Barrus in both the source window and destination window of Barrus and bright.net, *supra*, in order for the user to ensure the selected file is correct.

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Referring to claims 17 and 45, Barrus does not explicitly teach downloading a presentation for the host system for viewing after the connection has been terminated. However, bright.net shows an FTP method that enables a file to be downloaded from a host system onto the local system's drive. Since the file is saved locally, it can be opened (viewed) after the connection with the host computer is terminated. It would have been obvious to one of ordinary skill in the art to include the file transfer method of bright.net in the network of Barrus in order that multimedia message (presentations) may be saved on the local computer and viewed at the user's convenience as supported by bright.net.

7. Claims 24, 26, 52, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrus and U.S. Patent No. 6,161,137 to Ogdon et al. (hereinafter Ogdon).

Referring to claims 24 and 52, Barrus does not explicitly teach that the host system includes a report component that generates reports from the presentation information obtained by the tracking component. However, Ogdon teaches providing multimedia presentations over a telephony/internet network (col. 4, lines 1-17), which is similar to Barrus. Ogdon teaches a report component (content archival database) that generates reports from presentation information obtained by a tracking component. See col. 10, lines 5-19. It would have been obvious to one of ordinary skill in the art to include the report component of Ogdon in the host system of Barrus in order to record user activity for billing purposes as supported by Ogdon (col. 11, lines 21-31).

Referring to claims 26 and 54, Barrus does not teach a viewing receipt that includes presentation information recorded by the tracking component that is transmitted to the composer

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system when a presentation composed by the composer system is viewed by the viewer system. However, Ogdon teaches an accounting system that bills clients after receiving (viewing) a presentation and maintains a chart of accounts (receipts). See col. 11, lines 22-31. It would have been obvious to one of ordinary skill in the art to provide the viewing receipt (accounting chart) of Ogdon in the system of Barrus in order to maintain client billing records as taught by Ogdon.

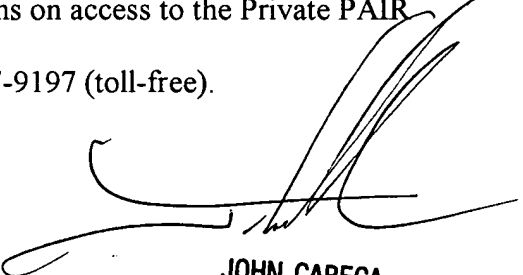
### *Conclusion*

8. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach methods of editing slide shows and adding audio to files.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn M. Becker whose telephone number is (571) 272-4046. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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